UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,757	04/08/1999	FRED L. HOROWITZ	991057	7857

		EXAMINER
7590	03/03/2006	RIMELL, SAMUEL G

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2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/288,757	HOROWITZ ET AL.
	Examiner	Art Unit	
	Sam Rimell	2165	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _4,6,13-18 and 28_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _4, 6, 13-18, 28_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Preliminary Notes: (1) This office action is non-final. (2) Applicant's supplemental

amendment of October 20, 2004 is approved for entry. The version of the claims examined is

based upon the version presented in this supplemental amendment of October 20, 2004. (3)

Claim 19 has been re-numbered as claims 28, since claim 19 previously existed. Accordingly,

the pending claims being examined are 4, 6, 13-18 and 28.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 4, 6, 13-18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pritchard (U.S. Patent 4,4,91,725).

Claim 4: Pritchard discloses a system (FIG. 1) for determining insurance eligibility and

payment for medical procedures. Within the preamble (lines −13) the recitation of a dental

procedure by a dental care provider is a recitation of intended use and carries no patentable

weight.   Pritchard discloses a first computer (26) having at lease one data storage means (files

and tables as shown at 26), and input/output means (each communication line 22, 24, 32 and 34

is both an input and output means to the first computer 26 since each permits two-way

communication).

Data pertaining to the participant is stored in a patient file at (26). The collective set of

patient files constitute a database. These files are not stored on a second computer (10).

The second computer is shown at (10). This second computer (10) includes means for

inputting a participant identifier simultaneously with an indicator of a particular procedure (the

HCFA form which requests the patient information and procedure information together on one

form, col. 7, lines 41-42, 45-46 and 49-50).

The first computer also includes means for searching for the participant identifier to

identify the participant (programming steps to find the participant and validate their card, col. 7,

lines 20-30).

The first computer (26) further includes means for providing the participant data to the

second computer in the form of an indication of correctness or non-correctness of eligibility for a

procedure, along with an identification of the procedure(s) and participant identifiers (FIG. 8,

illustrating the correctness of eligibility by providing a claim payment amount, and providing an

identification of the procedure (service number) and patient identifier (patient name).

The second computer (10) further includes second input means (keyboard or any of the

input means 60-66 shown in FIG. 4) which permit input of inquiries. Response to the inquires are

made in real time in the sense that the information is provided back to the medical care provider

"rapidly" (col. 3, line 30) and while the patient is still with the provider (col. 6, lines 64-66 and

col. 12, lines 14-15). The participant's data to the second computer (10) in not sent advance of

the determination (col. 7, lines 25-28 returns only a yes/no validation, the participant's data is not

returned to the second computer (10) until FIG. 8, where the participant data is shown with the

determination).

The recordation of utilization of benefits can be accomplished by the insurance carriers

(36, 38) or the bank (40) which record transaction which take place and are associated with the

first computer (10) by communications links over a common network (FIG. 1). The recordation

may also be record presented on the output screen in FIG. 8.

Pritchard differs from claim 4 in that FIG. 8 does not specify whether the eligibility for the claim payment is made for only one input procedure or the total of several procedures performed by the physician. However, the skilled would readily recognize that the physician could obtain the indications of eligibility for payment for only one input procedure if only one procedure was required to be performed. It would thus have been obvious to one of ordinary skill in the art to indicate correctness or non-correctness of eligibility for only one procedure if one procedure actually needed to be performed.

Pritchard also differs in that it does not deal with dental procedures (last paragraph of claim), although it would have been obvious to one of ordinary skill in the art to apply the system of Pritchard to evaluate dental procedures as a choice of design for the computer system.

Claim 6: Pritchard discloses the input of procedure codes (col. 8, lines 12-13). The input of other procedure related data, such as tooth identifications and tooth positional identification would further have been obvious to one of ordinary skill in the art to clarify the exact nature of the procedure being performed.

Claim 13: For claim 13, the "first computer" is (26) and the second computer is (10).

Pritchard discloses a method for providing information to physicians regarding participants in an insurance plan. The method involves determination of eligibility for claim payments and involves the steps of:

Inputting identifier data and particular procedure pertaining to a participant on a first computer as a single step inquiry to a database containing participant data regarding a plurality of insurance carriers (col. 7, lines 37-63, the steps of filling out the HCFA form that includes the

participant data and procedure information. The form is filled out on the first computer 10 and input to the second computer 26);

Searching for identifier data in the participant data (col. 7, lines 20-23);

Providing output in the form of participant data provided as a response to the inquiry in real time (FIG. 8) without the need to send the participant data in advance (FIG. 8 is the first output of participant data, the previous output described at col. 7, lines 25-28 is only a Yes/No validation) and where the output comprises an indication of correctness or non-correctness for the input procedure (FIG. 8, which illustrates that the procedure is correct since a claim payment is authorized by the insurer for the patient identified as John M. Doe).

The inputting step is performed in real time (col. 3, line 30, col. 6, lines 64-66 and col. 12, lines 14-15) and the inputs are transmitted to the second computer (26). The inputs may be made prior to the procedure itself (col. 6, lines 64-66).

The recordation of the utilization of benefits may be made by the insurer (36, 38), the bank (40) or it may be recorded on the output screen in FIG. 8. The recordation is based upon the input of the participant data and procedure data into the HCFA form.

Pritchard differs in that the output of FIG. 8 is not specified as being for a single particular procedure or for all the procedures input by the physician for the patient. However, the skilled artisan would readily recognize that the physician could obtain indications of correctness or non-correctness for only a single input procedure if the patient only required a single procedure to be performed. It would have been obvious to one of ordinary skill in the art to modify Pritchard to display the correctness/non-correctness indication for a single input procedure if the patient only required a single procedure to be performed.

Pritchard also differs in that it does not specify the providing of information to dental care providers, although it does specify a doctor's office (col. 4, line 38). Since a dentist is a type of doctor, it would have been obvious to one of ordinary skill in the art to provide the information to dentists and to tailor the information to dental information as a choice of design for the computer system.

Claim 14: Input data is inherently viewed in real time, since it is seen while it being entered in the computer. The output from the input data is also real time, since it is seen while the patient is with the physician (col. 6, lines 64-66).

Claim 15: The processing of every claim is considered to be an updating of data pertaining to eligibility, since new data is being processed and presented to the physician for that patient.

Claim 16: The inputs to the HCFA form are the inputs derived from the MediCard (col. 7, lines 45-46), which are described at col. 5, lines 26-32. This includes a date of birth. The features in claim 16 are optionally recited.

Claim 17: In filling out the HCFA form, a procedure code is input by the physician (col. 8, lines 12-13).

Claim 18: See remarks for claim 6.

Claim 28: See remarks for claim 4. Note that the system of Pritchard includes multiple patient files in computer (26), and thus inherently includes multiple participant identifiers. Also note that when the second computer receives input from a Medicard, it will then contain a subset of participant identifiers (one identifier for the one patient).

This action is non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at

telephone number (571) 272-4084.

Sam Rimell
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